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09/560,203	04/28/2000	Terry Erisman	12-066-US	3365
98804	7590	08/20/2012	EXAMINER	
Reed Smith LLP P.O. Box 488 Pittsburgh, PA 15230			FELTEN, DANIEL S	
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

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8 *Ex parte* TERRY ERISMAN

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11 Appeal 2011-002091
12 Application 09/560,203
13 Technology Center 3600

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17 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
18 MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

19 FETTING, *Administrative Patent Judge*.

20 DECISION ON APPEAL

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1 STATEMENT OF THE CASE¹

2 Terry Erisman (Appellant) seeks review under 35 U.S.C. § 134 of a
3 final rejection of claims 1-10, 37-70, 76 -81, 85-87, and 94-102², the only
4 claims pending in the application on appeal. We have jurisdiction over the
5 appeal pursuant to 35 U.S.C. § 6(b).

6 The Appellant invented a way of performing automated auctions by
7 bidding on items that are somewhat mutually exclusive, and/or performing
8 those types of auctions which are resolved on a collective basis with
9 reference to more than one demand constraint provided in a bid
10 (Specification 1:6-9).

11 An understanding of the invention can be derived from a reading of
12 exemplary claim 1, which is reproduced below [bracketed matter and some
13 paragraphing added].

14 1. A method of processing bid information for an electronic
15 auction comprising the steps of:
16 (a) providing a database of items available for auction;
17 (b) receiving a set of bids
18 from one or more bidders
19 for a corresponding set of items
20 selected from said database,
21 each bid in said set of bids including at least
22 a bid price

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.", filed October 3, 2007) and Reply Brief ("Reply Br.", filed December 2, 2009), and the Examiner's Answer ("Ans.", mailed October 2, 2009).

² The rejection states that claims 1-102 are rejected, but claims 11-36, 71-75, 82-84, and 88-93 are cancelled.

1 and

2 a bid ranking

3 [both] specified by a bidder for an item;

4 [b-1] wherein said bid ranking from said bidder for an item

5 represents a desired order in which

6 a bid is to be resolved in the electronic auction

7 compared to

8 any other bids made by such bidder

9 for other items in said database of items;

10 [b-2] further wherein said bidder can specify

11 that a set of ranked bids

12 submitted by such bidder for a set of items

13 should be treated as mutually exclusive,

14 such that the electronic auction determines at most a
15 single item

16 to be awarded to said bidder

17 from said set of ranked bids

18 by correlating a ranking relationship between
19 separate items bid on by said bidder.

20 The Examiner relies upon the following prior art:

Barzilai US 6,012,045 Jan. 4, 2000

Mori US 6,044,363 Mar. 28, 2000

Aggarwal US 6,151,589 Nov. 21, 2000

Godin US 6,266,652 B1 Jul. 24, 2001

Lange US 6,321,212 B1 Nov. 20, 2001

21 Claims 44-65 and 85-87 stand rejected under 35 U.S.C. § 101 as directed
22 to non-statutory subject matter.

1 Claims 1-10, 37-70, 76 -81, 85-87, and 94-102 stand rejected under 35
2 U.S.C. § 103(a) as unpatentable over Mori, Barzilai, Godin, Aggarwal, and
3 Lange.

4 The Appellant has decided not to contest the final rejection of claims 44
5 - 70 and 85 – 87 and has directed them to be cancelled. Reply Brief filed
6 February 24, 2009. According to 37 C.F.R. § 41.31(c) (2007), “[a]n appeal,
7 when taken, must be taken from the rejection of all claims under rejection
8 which the applicant or owner proposes to contest.” Because the Appellants
9 have decided not to contest the final rejection of claims 44 - 70 and 85 – 87,
10 and the Appellant has directed their cancellation, the Examiner should
11 cancel these claims upon return of the Application.

12 Thus the only rejection remaining is as follows.

13 Claims 1-10, 37-43, 76-81, and 94-102 stand rejected under 35 U.S.C.
14 § 103(a) as unpatentable over Mori, Barzilai, Godin, Aggarwal, and Lange.

ISSUES

16 The issue of obviousness turns primarily on whether the applied
17 references describe plural bids submitted and ranked by a single bidder.

FACTS PERTINENT TO THE ISSUES

19 The following enumerated Findings of Fact (FF) are believed to be
20 supported by a preponderance of the evidence.

Facts Related to the Prior Art

1. None of the applied references describe plural bids submitted and ranked by a single bidder.

1 ANALYSIS

2 All of the independent claims except for claim 6 recite bidders
3 submitting plural ranked bids. We are persuaded by the Appellant's
4 argument that none of the references describe this. The Examiner has not
5 shown this in the Answer, but instead invites us to piece together the
6 Examiner's findings from plural Office actions ("A discussion was made of
7 all the aforementioned prior art in office action dated May 16, 2003 and
8 October 31, 2003 with motivations to combine aforementioned references.")
9 Answer 6. This is improper procedure. We have reviewed all of the
10 Examiner's Office actions and are unable to determine how the Examiner
11 finds the references, particularly Mori and Barzilai, which appear to be
12 where the Examiner's citing for this feature, describe this limitation. In
13 particular, Barzilai's bid table is a ranking of different bidders' bids rather
14 than a ranking by a single bidder. We find the Examiner failed to present a
15 prima facie case.

16 As to claim 6, the Examiner presented no findings or response in the
17 Answer and so has failed to present a prima facie case here as well.

18 CONCLUSIONS OF LAW

19 The rejection of claims 1-10, 37-43, 76-81, and 94-102 under 35 U.S.C.
20 § 103(a) as unpatentable over Mori, Barzilai, Godin, Aggarwal, and Lange is
21 improper.

1 DECISION

2 The rejection of claims 1-10, 37-43, 76-81, and 94-102 is reversed.

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4 REVERSED

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